

REMARKS

Claims 1-13 are pending. In the Office Action dated June 16, 2006, claims 1-5 and 11-13 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Street (EP 1 151 718 A2). Claims 6-7 were rejected under 35 U.S.C. § 103(a) as being rendered obvious by Street in view of Hartley (US 6,161,042). Claim 8 was rejected under 35 U.S.C. § 103(a) as being rendered obvious by Street in view of Bonnet (US 6,574,507). Claims 9-10 were rejected under 35 U.S.C. § 103(a) as being rendered obvious by Street. Examiner also stated that an information disclosure statement filed on March 1, 2004 failed to comply with C.F.R. 1.98(a)(2). Applicant respectfully traverses the ground for these rejections below, and requests reconsideration of this application in view of the foregoing amendments and the following remarks.

I. Information Disclosure Statement

Examiner noted that an information disclosure statement filed on March 1, 2004 failed to comply with 37 C.F.R. 1.98(a)(2) due to the fact that an English translation was not provided for EP 0 970 713 A1. United States Patent No. 6,574,507 to Bonnet, a United States counterpart to the cited European patent which was disclosed in an October 24, 2003 information disclosure statement, is an accurate English translation of the European patent disclosure. For reference, this was expressly noted in the March 1, 2004 Information Disclosure Statement submitted by applicant at page 2.

II. 35 U.S.C. § 102(b) Rejection

Claims 1-5 and 11-13 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Street (EP 1 151 718 A2). Claim 1 has been amended. Applicant respectfully traverses the grounds for this rejection.

“[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference.” *Celeritas Techs., Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998). The standard for lack of novelty, that is, for “anticipation,” is one of strict identity. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296, 63 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2002). Although the Examiner is correct that Street discloses an apparatus for monitoring periodic breathing as an indication of changes in the hemodynamic status of the heart, Street does not disclose any functionality or structure for using the data acquired during monitoring to actually treat the periodic breathing episodes, as taught in amended claim 1. Thus, Street fails to disclose each and every element in amended claim 1, and applicant respectfully asks the Examiner to withdraw the grounds for this rejection.

III. 35 U.S.C. § 103(a) Rejections

Dependent claims 6-7 were rejected under 35 U.S.C. § 103(a) as being rendered obvious by Street in view of Hartley (US 6,161,042), dependent claim 8 was rejected under 35 U.S.C. § 103(a) as being rendered obvious by Street in view of Bonnet (US 6,574,507), and dependent claims 9-10 were rejected under 35 U.S.C. § 103(a) as being rendered obvious by Street. In view of the changes made to independent claims 1 (to which all of the claims above depend from either directly or indirectly), Applicant respectfully traverses the grounds for these rejections.

To establish a *Prima Facie* case of obviousness, there must be: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine references teachings; (2) a reasonable expectation of success; and (3) prior art references which teach or suggest all of the claim limitations. See *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); MPEP § 2143 (8th

Ed., Rev. 1). As discussed above, Street fails to disclose the means element found in amended independent claim 1 for "conditionally modifying an operating parameter of the device to treat a detected apnea or hypopnea when said detected contractility variation is significant." Moreover, Bonnet and Hartley, the secondary references cited by the Examiner in this Office action, both fail to disclose this feature, and thus do not cure the deficiency of the primary reference. Thus, Street, when considered alone or in combination with either Bonnet or Hartley, or both, fails to disclose all the elements taught in amended claim 1.

Furthermore, none of the references would motivate one to modify any of the references to include this functionality. Although Street discloses monitoring periodic breathing, none of the references disclose any means for applying a therapy to treat the apnea or hypopnea as claimed in amended claim 1. Indeed, Hartley discloses a rate adaptive cardiac rhythm management device that fails to address the issue of periodic breathing. Bonnet discloses a method for treating apneas, but fails to disclose any method or functionality for detecting and treating hypopneas. And, as discussed above, Street only discloses an apparatus and method for monitoring periodic breathing and fails to disclose any functionality or structure for applying a therapy when changes are detected. Applicant respectfully reminds the Examiner that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art *also suggests the desirability of the combination*. See MPEP, 8th Ed., at § 2143.01; *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Here, the prior art references, when combined, provide no suggestion of desirability in making the combination as evidenced by their failure to disclose all of the elements taught in amended claim 1.

For the foregoing reasons, Applicant respectfully asks the Examiner to reconsider and withdraw the §103(a) rejections noted above.

CONCLUSION

Applicant respectfully submits that it has made a patentable contribution to the art. Reconsideration of this application in view of the foregoing remarks respectfully is requested.

The Examiner is invited to call Applicant's undersigned attorney if doing so would expedite prosecution.

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Respectfully submitted,



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